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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,521	07/11/2003	Thomas F. Calton	40682/298	5072
33642	7590	10/10/2008		
STOEL RIVES LLP - SLC 201 SOUTH MAIN STREET ONE UTAH CENTER SALT LAKE CITY, UT 84111			EXAMINER SWIGER III, JAMES L	
			ART UNIT 3775	PAPER NUMBER
			MAIL DATE 10/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/618,521

Applicant(s)

CALTON ET AL.

Examiner

JAMES L. SWIGER III

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/13/2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-27 are rejected under 35 U.S.C. 101 because they are drawn to non-statutory subject matter. In claim 1, lines 14-15, applicant positively recites part of a human, i.e. "at least a portion of the device is anchored to the bone". Thus claims 1-37 include a human within their scope and are non-statutory. It is noted that applicant claims "a device" which isn't necessarily part of the "first member" configured to be attached to bone in line 3 of claim 1. It is suggested to rewrite that a portion of the device is "configured to be anchored to the bone."

In claim 2, lines 2-3, applicant positively recites part of a human, i.e. "at least one securing member implanted within and protruding from the bone." It is suggested to rewrite the claim to state "one securing member adapted to be implanted within and protrude from the bone."

A claim directed to or including within its scope a human is not considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution. In re Wakefield, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowman et al. (US Patent 4,952,213). Bowman et al. ("Bowman") disclose an orthopedic cutting guide device (see entire Fig. 1) comprising a first member (entire section on left which has a pivot axis extending along the length defined by the body of the first member, extending from 48 to approx bottom at 42), a second member (L-shaped section extending to the right and down), a cut guide (24) releasably secured directly to the second member, and wherein the first member is positioned between a cut guide and the second member and further wherein the cut guide and second member are able to move together and pivot about the axis of the first member. As the cut guide is adjustable, the second member may be selectively released from the first member. The cut guide member is also capable of independent movement from the second member, as they are adjustable with respect to one another and the first member. It is also noted that the device is configured to be selectively adjusted in both a rotational and translational manner while at least a portion of the device is anchored. Note the arrows in the device denoting various types of movement. With regards to intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Bowman et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims

under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Bowman further discloses an orthopedic cutting guide device that has at least one securing member (34) and a boom (142) that fits into an opening of the cutting guide (Fig. 1, inserted into top opening). The cutting guide also has various surfaces to assist in guiding a tool, the first member has various surfaces such as a first and second side, also has a tapering(ed) portion (42) which extends from a point on the first member. The cutting guide portions also have various holes, some of which are considered substantially arcuate. On the first member, the notches further create protrusions within the segments (44), and also a securing member (84) for assisting in the connection between the first and second members. The device also has markings (74/84) that assist in the manipulation and orientation of the device. The cut guide also has what is considered an anterior cutting guide, as the side has tapered sections and the various sides may be used to guide a cutting instrument. The cutting guide also has a recessed area (152).

Response to Arguments

Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER III whose telephone number is (571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/
Examiner, Art Unit 3775
/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733

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